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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,292	08/13/2001	Marc A. Messner		7418

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EXAMINER

ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,292

Applicant(s)

MESSNER, MARC A.

Examiner

Pierre E. Elisca

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to Applicant's RCE filed on 02/09/2006.
2. Claims 1-3 are pending.

Allowable Subject Matter

3. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Wang (U.S. pat. No. 6,282,656) in view of Ruppert et al (U.S. Pat. No. 5,640,002)..
As per claim 1 Wang substantially discloses a method for completing a transaction request pertaining to an electronic transaction conducted over an electronic network having a server and a requesting device. A portable electronic authorization device for executing approval transaction request (which is readable as Applicant's claimed

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invention wherein said an electronic apparatus for providing security of specified electronic transactions), comprising:

An article removably (item 200) inserted into the personal electronic apparatus, the article bearing machine readable code (see., figs 3A, 3B and fig 4, abstract, col 5, lines 10-67, col 7, lines 8-39);

Customer-specific code installed on and retained by the personal electronic apparatus, the code affecting operation of the personal electronic apparatus (see., figs 2, 3A, 3B and fig 4, abstract, col 5, lines 10-67, col 7, lines 8-39, col 8, lines 8-67, specifically encryption code or logic);

Verifying means for determining whether the article is installed in the personal electronic apparatus, and if so, for enabling specified electronic transactions, but, if not, for preventing said transactions (see., figs 2, 3A, 3B and fig 4, abstract, col 5, lines 10-67, col 7, lines 8-39, col 8, lines 8-67, specifically wherein said approval transaction device associated with the requesting terminal..., fig 11);

Whereby, upon a request for specified electronic transactions by the user, the personal electronic apparatus queries whether the article is installed, and, if so, enables specified transactions to be performed at the request of the user, but prevents the transaction from being performed if the article is not installed (see., figs 2, 3A, 3B and fig 4, abstract, col 5, lines 10-67, col 7, lines 8-39, col 8, lines 8-67, specifically wherein said approval transaction device associated with the requesting terminal..., fig 11, col 15, lines 30-67, col 16, lines 8-55).

Wang fails to explicitly disclose Applicant's newly added limitation wherein said a keycode for authenticating the article and a pin number for authenticating a user. However, Ruppert discloses a portable barcode RF ID tag reader that can also be used in authenticating articles, a pin , and a key lock code (see., abstract, col 23-col 49). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Wang by including the limitation detailed above as taught by Ruppert because this would detect and authenticate the identity of a user.

As per claim 2 Wang discloses a method for completing a transaction request pertaining to an electronic transaction conducted over an electronic network having a server and a requesting device. A portable electronic authorization device for executing approval transaction request (which is readable as Applicant's claimed invention wherein said a method of purchasing goods and services via the Internet), comprising:

Providing the personal electronic apparatus of claim 1; creating a customer account at a bank pursuant to communication with the customer and relaying to the customer a pin number (figs 1, items 108 and 109) that will be required in a later step (see., fig 1, col 2, lines 9-61. Please note that item 108 is for inserting a PIN number; creating customer-specific software at the bank, then splitting the software into a first portion, which is written to the article and a second portion which is transmitted to a bank download server; mailing the article to the customer (fig 1, item 107), who then inserts it into the personal electronic apparatus; the customer contacting the bank (fig 9, items 902 and 904) download server via internet and downloading the second portion to the personal

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electronic apparatus, then the bank download server erasing the copy of the second portion, from the download server, but retaining relevant information on a bank purchase server; and upon provision of the pin number by the customer, the personal electronic apparatus linking the first and second portion into working software on the personal electronic apparatus (see., figs 3A, 3B, fig 4 and fig 9, abstract, col 5, lines 10-67, col 7, lines 8-39, col 14, lines 48-67, col 15, lines 1-67.

RESPONSE TO ARGUMENTS

6. Applicant's arguments filed on 02/09/2006/4/2005 have been fully considered but they are moot in view of new ground (s).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 571 272 6706. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571 272 6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent Examiner

February 24, 2006